

**REMARKS**

Claims 1-12 are pending in this application. Claim 1 is in independent form. No claims are amended in response to current rejections.

**Information Disclosure Statement**

Applicants request acknowledgement of receipt and consideration of the Information Disclosure Statement filed on November 17, 2006.

**Rejections Under 35 U.S.C. §102**

Claims 1-12 stand rejected under 35 U.S.C. §102(a) as being anticipated by WO/2004/072203 using US Patent Application Publication 2006/0240748 to Ohta et al. (Ohta) as an English language equivalent. The rejection is respectfully traversed.

Applicants submit that WO/2004/072203 is not available as a prior art reference under 35 U.S.C. §102(a) because the priority date of the present application (March 29, 2004) precedes the publication date of the applied reference (August 26, 2004). The claim for priority to JP 2004-096847 is hereby perfected by submission of the attached verified English language translation of the priority document.

Because the applied reference fails to qualify as prior art, a *prima facie* case of obviousness has not been established. Therefore, withdrawal of the rejection is respectfully requested.

**Rejections Under 35 U.S.C. §103**

Claims 1-2, 4, 5, 7 and 10 stand rejected under 35 U.S.C. §103(a) as being unpatentable

over JP 2003-268354 to Keiji. The rejection is respectfully traversed.

In rejecting the claims the Examiner relies on a foreign language reference having only an English language abstract. When relying on a foreign language document in support of a rejection, “if the document is in a language other than English and the Examiner seeks to rely on that document, a translation must be obtained so that the record is clear as to the precise facts the Examiner is relying upon in support of the rejection (MPEP §706.02). Further, when relying on an English language Abstract, the evidence relied upon is the facts contained in the Abstract, not additional facts that may be contained in the underlying full text document. As the Examiner appears to rely on more than the Abstract (i.e., “Drawing 1”) the rejection is improper.

Moreover, there is nothing in the Abstract that discloses or suggests the pH of the silica particles after a 10 day shake test. Although the Examiner admits that Keiji is silent regarding the increased rate of dispersion he alleges that “it would be expected the fumed silica dispersion made by a substantial[ly] similar process to have the same properties...absent any evidence to the contrary.” The Examiner also refers to Drawing 1 of Keiji without explanation of the relevance of the drawing.

As discussed above, any reliance on the underlying foreign language reference is improper. Further, it appears that the Examiner believes the claimed features to be inherent. However, as inherency is a basis of rejection under anticipation which requires that “the missing descriptive matter is necessarily present in the thing suggested by the reference” an inherency argument is inapplicable in the present case.

Finally, due to the several differences in the silica concentration, pH and due to the lack of any description in Keiji of particle size, there is no reason to surmise that the silica composition of Keiji corresponds to the claimed polishing composition.

As Keiji fails to disclose or suggest the features of the rejected claims, withdrawal of the rejection is respectfully requested.

Claims 3, 6, 8, 9, 11 and 12 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Keiji in view of US Patent 7,211,122 to Iwasa. The rejection is respectfully traversed.

Claims 3, 6, 8, 9, 11 and 12 are allowable for their dependency on independent claim 1 for the reasons discussed above, as well as for the additional features recited therein. Therefore, withdrawal of the rejection is respectfully requested.

#### **CONCLUSION**

In view of the above remarks and amendments, Applicants respectfully submit that each of the rejections has been addressed and overcome, placing the present application in condition for allowance. A notice to that effect is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to contact the undersigned.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact John W. Fitzpatrick at the telephone number of the undersigned below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

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By



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